

REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated April 20, 2007.

Claim Rejections - 35 USC § 112

Claim 1 has been amended to address the Examiner's rejections under 35 USC 112. Specifically, claim 1 now recites the feature of "the digital ink being a sequence of captured pen strokes", as suggested by the Examiner.

Furthermore, claim 1 has been re-cast so as to address the Examiner's rejection that the claims contain a clause of intended use. In particular, the step of operatively positioning the pen relative to the bill is now positively recited in claim 1.

System claim 29 has been similarly amended.

Claim Rejections – 35 USC § 103

The Examiner has rejected claim 1 under 35 USC 103 based on the combined teachings of Speiser and Buckley. The Applicant contests this rejection on two grounds.

Buckley Does Not Qualify as Prior Art

In the first place, the Applicant contends that Buckley does not qualify as relevant prior art under 35 USC 102 and cannot, therefore, be used to argue obviousness under 35 USC 103.

Buckley is a WIPO publication having a publication date of 23 December 1999. By virtue of a claim to foreign priority (Australian Application No. PQ0559), the present application has an effective date of 25 May 1999.

Hence, the effective date of the present application is *earlier* than the publication date of Buckley (WO99/66441).

The changes to 35 USC 102(e), which recognizes WIPO publications as prior art, took effect on November 29 2000. The USPTO specifically directs that "no international filing dates prior to November 29 2000 may be relied upon as a prior art date under 35 USC 102(e)".

Thus, Buckley qualifies as prior art only under 35 USC 102(a). Buckley does not qualify as prior art under 35 USC 102(e).

Since Buckley qualifies as prior art only under 35 USC 102(a), and since the present application has an earlier effective date than the publication date of Buckley, the Applicant submits that the rejection of obviousness based on the teaching of Buckley is improper.

Buckley Does Not Teach "Data Indicative of Position of Pen"

Secondly, the Applicant submits that Buckley fails to teach the claim feature of "each stroke containing data indicative of ... a position of the pen relative to the bill".

Buckley merely teaches a pen which sends data indicative of a URL to a computer system. At page 6, lines 18-20, Buckley states:

The periodical 10 also includes a barcode 14 located at the bottom of the second column. As discussed, the barcode may contain a unique identifying code to identify the article.

Buckley, then, teaches barcodes identifying an article (which corresponds to Applicant's "identity of the bill"), but fails to teach coded data identifying a plurality of locations and, likewise, fails to teach "each stroke containing data indicative of ... a position of the pen relative to the bill".

These claim features cannot be found anywhere in Buckley and certainly not in the passages identified by the Examiner, which relate to transfer of data to a computer system.

Accordingly, it is submitted that Buckley does not make up for the shortcomings of Speiser, and that the present invention is not obvious in view of the combined teachings of Speiser and Buckley.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.
Very respectfully,

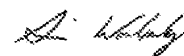
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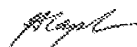
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